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Bert Whitmore Elliott

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EXAMINER

KWIECINSKI, RYAN D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERT WHITMORE ELLIOTT

Appeal 2009-003919
Application 09/515,928
Technology Center 3600

Before LINDA E. HORNER, MICHAEL W. O'NEILL, and
KEN B. BARRETT, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Bert Whitmore Elliott (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 67 and 68 under 35 U.S.C. § 103(a) as obvious over Phillips (US 6,014,847, issued Jan. 18, 2000) in view of Overbury (US 1,843,370, issued Feb. 2, 1932) and claims 17, 46-48, 53-58, 65-68, and 70 as obvious over Hulett (US 5,195,290, issued Mar. 23, 1993) or Bondoc (US 5,939,169, issued Aug. 17, 1999) in view of Overbury. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

The Invention

The claims on appeal relate to a roof covering that includes plural successive generally horizontal courses of laminated shingles, where the shingles of each course are laid in a side-by-side relationship and horizontally offset from the shingles in adjacent courses. Each shingle includes a plurality of tabs. Each tab has a single color blend. The color blends of some of the tabs of each shingle being a color blend different from the color blends of other tabs. One of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend for the roof covering. The frequency of the tabs with the predominant color blend in the roof covering are sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof.

Claim 17, reproduced below, is illustrative of the subject matter on appeal.

17. A roof covering including a plurality of successive generally horizontal courses of laminated shingles, the shingles in each course being laid in a side-by-side relationship and

horizontally offset from the shingles in adjacent courses, each laminated shingle comprising:

an overlay member having front and rear surfaces, the overlay member including a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts, each tab including a layer of granules on the front surface forming a generally uniform color blend, and each cutout being narrow when compared to the width of the tabs to provide an overall roof covering appearance of a natural slate roof; and

an underlay member having a front surface attached to the rear surface of the overlay member;

wherein each tab has a single color blend, the color blends of some of the tabs of each shingle being a color blend different from the color blend of others of the tabs; and

wherein one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend, with the frequency of the tabs of the predominant color blend in the roof covering being sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof.

The Rejections

The Examiner acknowledges that Phillips, Hulett, and Bondoc fail to teach color blends of tabs being different from one another with one of the color blends occurring more frequently than any of the other color blends. Ans. 4, 6, and 8. The Examiner finds that Overbury teaches the confinement of different colors to different tabs of a shingle, that multiple tabs may be given the same color, and that Overbury's Figure 6 shows multiple tabs of different colors "with one of the tabs (left most) being predominant." Ans. 4, 6, and 8. Based on these findings, the Examiner concludes that it would have been obvious to provide the tabs of Phillips, Hulett, or Bondoc "with color blends different from one another with one color blend occurring more

frequently, as taught by Overbury, to achieve a desired artistic effect.” Ans. 4, 6, and 8.

Contentions

Appellant contends, *inter alia*, “[t]here are a number of reasons why a skilled artisan would conclude that the Overbury reference fails to supply the missing limitation of the predominant color blend being sufficiently prevalent to provide the appearance of a roof covering that simulates a natural slate roof.” App. Br. 9. As evidenced by the Elliott and Vermilion declarations, Appellant asserts that the exposed portions of natural slate roof tiles have a single color, with at least about 60% of the tiles being of a predominant color. As explained by Appellant, a predominant color exists because a natural slate roof has one color that occurs more frequently than the other colors. App. Br. 9-10.

DISCUSSION

Pertinent Facts

1. Mr. Vermilion is a senior research associate employed by the assignee, obtained a Bachelor of Science in chemistry, has worked on various roofing and asphalt products for the assignee for over 34 years, and was a project leader for the development of plastic resin tiles that simulated natural slate roofs when installed on a roof deck. Vermilion Decl., paras. 1 and 2. We find Mr. Vermilion is qualified to opine as to how a person of ordinary skill in the art would interpret the claim language and understand the prior art.
2. The Vermilion Declaration states “[h]aving a predominant color means that a natural slate roof has one color that occurs more

frequently than the other colors in the roof. It also means that the more frequent color occurs sufficiently to be a prevalent color, and that the remaining colors are present for accent or variety.” Vermilion Decl., para. 5.

3. The Vermilion Declaration states, “a natural slate roof typically has the appearance of at least 60% of the predominant color....

Commonly, the area of predominant color of a natural slate roof is substantially higher than 60%, such as, for example 70-80%.”

Vermilion Decl., para. 6.

4. The Vermilion Declaration states,

the term “natural slate roof” has a meaning in the roofing industry of a roof covering having the appearance of exposed portions of individual tiles partially overlaid by tiles of succeeding courses of individual tiles. Each of the exposed portions of a tile has a single color, with at least about 60% of the tiles being of a predominant color, and typically significantly more than 60% of the tiles being of a predominant color.

Vermilion Decl., para. 7.

5. The Vermilion Declaration states, “I have read the above-identified patent application I note that the independent claims define a roof covering that has an appearance that simulates a natural slate roof.”

Vermilion Decl., para. 8.

Principles of Law

Words in claims “are generally given their ordinary and customary meaning” to a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc) (citations omitted). How a person of ordinary skill in the art interprets a

claim term is based on the “understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art.” *Id.* at 1313. Accordingly, when construing a claim, unless the inventor has set forth a definition for a term, that term will be given its ordinary and customary meaning as understood by one skilled in the pertinent art. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (citations omitted).

Analysis

Claim Construction

As claim terms are construed as they would be interpreted by persons skilled in the art, we look to the Vermilion declaration for guidance in construing the claimed aspect of the tabs having a predominant color blend such that the frequency of the tabs with this color blend is sufficiently prevalent to provide the claimed roof covering combination with an appearance that simulates a natural slate roof. We find Mr. Vermilion is qualified to opine how a person of ordinary skill in the art would interpret the claimed predominant color feature. FF 1. Mr. Vermilion states that the predominant color for a slate roof is the color that occurs more frequently than others and typically occurs with the frequency of at least 60 %, commonly within the range of 70%-80%. FF 2 and 3. Mr. Vermilion states that the term “natural slate roof” has a particular meaning within the roofing

industry of a roof covering having an appearance of exposed portions of individual tiles partially overlaid by tiles with succeeding courses of individual tiles where each of the exposed tile portions has a single color that occurs with the frequency of at least about 60%. FF 4. Mr. Vermilion states that he has read the present patent application and understands that the independent claims define a roof covering that simulates a natural slate roof. FF 5.

As such, since Mr. Vermilion states that a natural slate roof has a predominant color that occurs at least with the frequency of 60%, commonly 70-80%, and Mr. Vermilion states that he understands the patent application and claims are directed to a roof covering that simulates a natural slate roof, then a person of ordinary skill in the art would interpret the claimed feature of a predominant tab color blend occurring with a frequency that is “sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof” as a color blend that occurs with at least 60% frequency. With this understanding as to how a person of ordinary skill in the art would interpret the claim, we compare the properly construed claim to the prior art reference the Examiner utilized to render obvious this claimed feature.

Comparison to the Prior Art

The Examiner utilized Overbury for the teaching of providing a predominant tab color blend. Ans. 4. The Examiner’s reasoning that Overbury teaches a predominant tab color blend feature, as set forth in the claim, is premised upon viewing Overbury’s Figure 6. The Examiner posits that since the left most tab has the largest surface area when comparing the individual tabs and is of one color, and since Overbury teaches that two or

more adjacent tabs “may now and then” be the same color, the one color on the left most tab predominates the other colors on the other tabs. *See* Ans. 4 and 10.

Appellant challenges the sufficiency of the Examiner’s findings noted above. App. Br. 10-11. Appellant submits Mr. Vermilion’s declaration as evidence to demonstrate how a person would understand the scope and content of Overbury. Appellant argues, based on the calculations performed by Mr. Vermilion from visual inspection of Figures 6 and 8, *see* Vermilion Declaration, paras. 13-15, a person of ordinary skill in the art would understand the color blend of the color within the left most tab to be about one-third the surface area of the shingle. Appellant argues that this low percentage of color blend is insufficient to render the color blend a predominant color sufficiently prevalent in order for the roof covering to have the appearance of a natural slate roof. App. Br. 11. Moreover, Appellant argues and premises the argument with Mr. Vermilion’s statements, *see* Vermilion Declaration para. 12, that the term “now and then” as used in Overbury would be understood by persons of ordinary skill in the art as meaning only “occasionally” and not to mean that one color within a shingle would predominate the other colors based on multiple tabs having the same color and possibly being adjacent as determined by the Examiner. *Id.*

Accordingly, Appellant argues that the scope and content of Overbury, as understood by persons of ordinary skill in the art, would teach that the prevalent color blend within a single shingle would have the frequency of occurrence of about one-third of the time, i.e., 33% frequency. *Id.* Appellant argues that such a low percentage of frequency is insufficient

to permit an overall roof covering to have the appearance of a natural slate roof. *Id.*

As discussed above, the claim feature at issue between the Examiner and Appellant requires the predominant color blend to occur with at least 60% frequency in order to be sufficiently prevalent to permit the claimed roof covering combination to have an appearance that simulates a natural slate roof. Overbury's prevalent color blend, based on the evidence supplied by Appellant and uncontested by the Examiner, is about 33% frequency. Accordingly, Overbury's 33% frequency is insufficient to render obvious the claimed feature requiring the predominant color blend to occur with at least 60% frequency, as understood by an artisan as evidenced by the Vermilion declaration, in order to be sufficiently prevalent to permit the claimed roof covering combination to have an appearance that simulates a natural roof. Furthermore, the Examiner does not provide adequate reasoning to support the conclusion that the claimed percentages "would have been nothing other than obvious choices of design" Ans. 5; *see also* Ans. 7, 9, 10.

The Examiner does not utilize Phillips, Bondoc, or Hulett to cure the deficiency of Overbury concerning the claimed feature of the predominant color blend occurring with a frequency sufficiently prevalent to permit the claimed roof covering combination to have an appearance that simulates a natural slate roof.

DECISION

In view of the foregoing, the Examiner decision to reject the claims as obvious is reversed.

REVERSED

Appeal No. 2009-003919
Application No. 09/515,928

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